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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/616,010	Applicant(s) BURNETT ET AL.
	Examiner JOSHUA MURDOUGH	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 January 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-27 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 January 2008 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-166/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 3, 5, and 11-13 have been cancelled and a new claim 28 has been added in Applicants amendment received on 11 January 2008.
2. Claims 1, 2, 4, 6-10, and 14-28 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8, 9, 14, 15, 17, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Iannella (ODRL).

5. As to claim 1, Iannella shows:

A method of enabling a Digital Item to be consumed or otherwise manipulated according to a set of operations defined by the Digital Item author or other entitled party, (Section 2.2)

the method including the step of incorporating a Digital Item manipulation method or methods defining said set of operations into the Digital Item. (Section 2.1 & Figure 1, the Asset block is shown to also contain Expression Language, therefore, the asset is the resource, the expression language is the metadata and the structure is inherent to any file containing separate sections.)

6. As to claim 8, Iannella further shows:

the Digital Item manipulation method includes an Intellectual Property Management and Protection (IPMP) mechanism. (Section 2.2)

7. As to claim 9, Iannella further shows:

the step of protecting said device using said IPMP mechanism. (Section 2.2)

8. As to claim 14, Iannella further shows:

said set of operations is described in a script.

As noted in the previous office action, the commonly accepted definition of a script is:

“A set of commands written in an interpreted language to automate certain application tasks.”

Applicant has not traversed this definition. When the code of ODRL is interpreted, there are automatic control tasks that are executed, such as allowing or denying access. Therefore, the use of ODRL to perform these tasks also shows that the operations are in a script.

9. As to claim 15, Iannella further shows:

said script is included in the Digital Item as a resource within the Digital Item accessed by a reference URI from the Digital Item declaration (Section 2.7 – External Reference)

10. As to claim 24, Iannella further shows:

a step of determining whether the device can perform the Digital Item manipulation method. (Section 2.3 – Device Constraint)

11. As to claim 25, Iannella further shows:

the step of identifying elements of the Digital Item which can be processed by the Digital Item manipulation method. (Section 2.3 – Target Constraints)

12. As to claim 17, Iannella further shows:

 said script is referenced by an identifier such that a device, or a family of devices
 might have the operations of said script in-built at manufacture or by later
 modification

 As previously shown, Iannella allows for reference to an external script, (Section 2.7 – External Reference) and also allows for execution based on hardware (Section 2.3 – Device Constraint). In combination, these elements allow for a script referenced by an identifier to a location on a device to be run if the device meets certain criterion, such as being in a certain family of devices.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Song (20020095429) in view of Applicants Admitted Prior Art.

15. As to claim 2 Song shows:

 A method of enabling a Digital Item to be consumed or otherwise manipulated
 according to a set of operations defined by the Digital Item author or other
 entitled party, (Paragraph 37)

 the method includes the following steps:

incorporating a Digital Item manipulation method or methods defining said set of operations into a Digital Item; (Figure 1)

providing said Digital Item, or a Digital Item declaration to a device; (Paragraph 2, being transferred shows that it is being provided to another device)

Song does not show:

enabling said device to:

- a. determine an appropriate Digital Item manipulation method or methods for the application;
- b. retrieve said appropriate Digital Item manipulation method or methods;
- c. interpret said set of operations from said appropriate digital item manipulation method or methods; and
- d. perform interpreted set of operations from said digital item manipulation method or methods on said digital item

The Applicants admit that it is notoriously old and well known in the art to use a direct execution interpreter, which performs the steps a-d above, in conjunction with a script. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Song to have used a direct execution interpreter to allow for the execution of the code on a broad range of devices.

16. As to claims 4, Song further shows:

configure said appropriate Digital Item manipulation method or methods for said Digital Item (Paragraph 77)

17. As to claim 6, Song further shows:

the Digital Item manipulation method is provided within the Digital Item or the
Digital Item declaration. (Figure 1)

18. As to claim 7, Song further shows:

receiving predetermined information including at least one of information regarding
user preferences, device capabilities and consumption environment and utilizing
the predetermined information, in part, to configure the appropriate Digital Item
manipulation method. (Paragraph 12)

19. Claims 10 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Song (20020095429) in view of Applicants Admitted Prior Art.

20. As to claim 10, Song shows:

Apparatus for enabling a Digital Item to be consumed or otherwise manipulated
according to a set of operations defined by the Digital Item author or other
entitled party, (Paragraph 37)

the apparatus including:

means for incorporating a Digital Item manipulation method or methods defining said
set of operations into a Digital Item; (Figure 1)

means for providing said Digital Item, or a Digital Item declaration to a device;
(Paragraph 2, being transferred shows that it is being provided to another device)

Song does not show:

said device including:

means for determining an appropriate Digital Item manipulation method or methods
for the application;

means for retrieving said appropriate Digital Item manipulation method or methods;
means for interpreting said set of operations from said appropriate Digital Item
manipulation method or methods; and
means for performing said interpreted set of operations from said Digital Item
manipulation method or methods on said Digital Item.

The Applicants admit that it is notoriously old and well known in the art to use a direct execution interpreter, which provides the means for performing the steps above, in conjunction with a script. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Song to have used a direct execution interpreter to allow for the execution of the code on a broad range of devices.

21. As to claim 26, Song further shows:

means for determining whether the device can perform the Digital Item manipulation method. (Figure 1, 102d)

22. As to claim 27, Song further shows:

means for identifying elements of the Digital Item which can be processed by the Digital Item manipulation method. (Figure 1, 102e)

23. As to claim 28, Song further shows:

means to receive predetermined information including at least one of information regarding user preferences, device capabilities and consumption environment, and utilize the predetermined information, in part, to configure the appropriate Digital Item manipulation method. (Figure 1, 104f)

24. Claims 10, 18-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iannella in view of Applicants Admitted Prior Art.

25. As to claim 10, Iannella shows:

Apparatus for enabling a Digital Item to be consumed or otherwise manipulated

according to a set of operations defined by the Digital Item author or other
entitled party, (Section 2.2)

the apparatus including:

means for incorporating a Digital Item manipulation method or methods defining said
set of operations into a Digital Item; (Section 2.12.1)

means for providing said Digital Item, or a Digital Item declaration to a device;
(Paragraph 11, being transferred shows that it is being provided to another device)

Iannella does not show:

said device including:

means for determining an appropriate Digital Item manipulation method or methods
for the application;

means for retrieving said appropriate Digital Item manipulation method or methods;
means for interpreting said set of operations from said appropriate Digital Item
manipulation method or methods; and

means for performing said interpreted set of operations from said Digital Item
manipulation method or methods on said Digital Item.

The Applicants admit that it is notoriously old and well known in the art to use a direct execution interpreter, which provides the means for performing the steps above, in conjunction with a script. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Iannella to have used a direct execution interpreter to allow for the execution of the code on a broad range of devices.

26. As to claim 18, Iannella further shows:

the Digital Item manipulation method includes an Intellectual Property Management and Protection (IPMP) mechanism. (Section 2.2)

27. As to claim 19, Iannella further shows:

means for protecting said device using said IPMP mechanism. (Section 2.2)

28. As to claim 20, Iannella further shows:

said set of operations are described in a script.

The commonly accepted definition of a script is: "A set of commands written in an interpreted language to automate certain application tasks." When the code of ODRL is interpreted, there are automatic control tasks that are executed, such as allowing or denying access. Therefore, the use of ODRL to perform these tasks also shows that the operations are in a script.

29. As to claim 21, Iannella further shows:

said script is included in the Digital Item as a resource within the Digital Item accessed by a reference URI from the Digital Item declaration (Section 2.7 – External Reference)

30. As to claim 23, Iannella further shows:

said script is referenced by an identifier such that a device, or a family of devices

 might have the operations of said script in-built at manufacture or by later
 modification

As previously shown, Iannella allows for reference to an external script, (Section 2.7 – External Reference) and also allows for execution based on hardware (Section 2.3 – Device Constraint). In combination, these elements allow for a script referenced by an identifier to a location on a device to be run if the device meets certain criterion, such as being in a certain family of devices.

31. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannella in view of Song.

32. Regarding claim 16, it can be seen that, as applied to claim 14, Iannella shows all of the elements except:

 said script is provided within the Digital Item declaration itself as a descriptor
 Song shows the use of the descriptor for “the purpose of selective item configuration.”
(Paragraph 77) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Iannella, so that the script was in the descriptor because, this would have allowed the digital item to be adapted to “various types of networks and terminals, or user requests.” (Paragraph 77)

33. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iannella in view of Applicants Admitted Prior Art as applied to claim 20 above, and further in view of Song.

34. Iannella in view of Applicants Admitted Prior Art shows all of the elements except:

 said script is provided within the Digital Item declaration itself as a descriptor

Song shows the use of the descriptor for “the purpose of selective item configuration.”

(Paragraph 77) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Iannella, so that the script was in the descriptor because, this would have allowed the digital item to be adapted to “various types of networks and terminals, or user requests.” (Paragraph 77)

Claim Interpretations

35. Since Applicants did not seasonably traverse the Official Notice statements as stated in the previous Office Action mailed on 9 July 2007, the Official Notice statements are taken to be admitted prior art. See MPEP 2144.03

36. Claims 10, 18-23, and 26-28 are interpreted as apparatus claims. “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.” (MPEP 2114) “[A]pparatus claims cover what a device is, not what a device does.” (Id.) Therefore, while the functional limitations have been addressed, it is the Examiner’s principal position that the functional limitations are only given full patentable weight when they impact structural elements of the invention.

Response to Arguments

37. Applicant’s arguments filed 11 January 2008 have been fully considered but they are not persuasive.

38. Applicants argue:

Iannella does not show a Digital Item which is a package containing structure, metadata and resources. (Applicants remarks, page 7, paragraph 4)

Examiner's response:

While the Examiner believes that Iannella does show the argued elements as clarified in the objection above, the argued limitations are not found in the claim. The Applicants have relied on the definition on page 1 of the specification to include these elements. However, within the definition being relied upon, although in a portion not cited by the Applicants, it is also stated that "other definitions are equally applicable." (Page 1, line 24) Therefore, the Examiner contends that any digital file or even parts thereof could reasonably be interpreted as a Digital Item.

In order to require a Digital Item to contain the structure, metadata, and resources as argued, these limitations need to be present in the claims or the definition in the specification needs to be amended to comply with MPEP 2111.01(IV).

39. Applicants argue:

"Song is wholly silent on the manipulation of Digital Items such that content within the Digital Item may be presented, consumed or otherwise manipulated by an application software using a set of manipulation operations incorporated into the digital item." (Applicants remarks, page 8, last paragraph) "[T]he cited paragraph discloses providing digital item descriptors (e.g. murCondition, opCondition, etc.) which do not in any way define a set of operations which allow

an author or other entitled party to define the way in which the digital item is consumed, or otherwise manipulated.” (Id.)

Examiner's reply:

It can clearly be seen in Figure 1 that the Digital Item **100** contains the resources **100a** (content) as well as metadata **100b**. Furthermore, in Figure 2, the resource **201a** and the metadata **203a** are packaged with the murCondition **204a** and the opCondition **205a**. The opCondition defines the rate at which the resource is to be consumed through the bit and sampling rates **205b**, while the murCondition sets conditions on the type and cost of consumption or manipulation allowed by the receiving party **205b**. The conditions necessarily have associated operations or mechanisms to enforce the conditions.

40. Applicants argue:

“Thus, even if Song were to be combined with Iannella there would be no teaching or suggestion of a method of enabling a digital item to be consumed or otherwise manipulated by incorporating a digital item manipulation method or methods defining a set of operations into the digital item, as presently claimed.” (Applicants remarks, Page 9, paragraph 1)

Examiner's reply:

It is believed that Applicants consider use, such as playing content, and consumption as distinct. However, the Applicants clearly state that consumable resources "include text, image, audio, and video resources." (Applicants specification, page 12, lines 19-21) As Iannella shows MPEG video resources and Song shows mp3 audio resources, clearly, according to Applicants' specification, both of these are consumable. A commonly accepted definition for consume, "vi 2: to utilize economic goods," (Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A., 1986) has been used by the Examiner in the interpretation that use is consumption. Therefore both Iannella and Song show the consumption of resources (Ianella, Page 5, Paragraph 1 & Song, Figure 2, element 204b)

Conclusion

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
42. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621